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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,978	12/11/2006	James W. Halbrook	N0260.70068US01	1639
	7590	EXAMINER		
600 ATLANTIC	C AVENUE	ANDERSON, REBECCA L		
BOSTON, MA	02210-2200		ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			05/28/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary		A	Application No.	Applicant(s)				
			10/550,978	HALBROOK ET AL.				
		E	xaminer	Art Unit				
		F	REBECCA L. ANDERSON	1626				
Period fo	The MAILING DATE of this communi or Reply	cation appea	rs on the cover sheet with the	correspondence ad	ddress			
WHIC - Exter after - If NC - Failu Any (	ORTENED STATUTORY PERIOD FOR CHEVER IS LONGER, FROM THE MANSIONS OF THE MANSIO	AILING DAT of 37 CFR 1.136(a unication. tutory period will a will, by statute, ca	E OF THIS COMMUNICATIO  a). In no event, however, may a reply be ti  apply and will expire SIX (6) MONTHS fron use the application to become ABANDONI	N. mely filed the mailing date of this of ED (35 U.S.C. § 133).	·			
Status								
1) 又	Responsive to communication(s) file	d on 9 <i>March</i>	n 2010.					
•	•		ction is non-final.					
′=	Since this application is in condition	<i>′</i> —		osecution as to th	e merits is			
,	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Dispositi	on of Claims							
4)⊠	Claim(s) 1,9 and 22-24 is/are pendin	g in the appl	ication.					
	4a) Of the above claim(s) is/are withdrawn from consideration.							
	5) Claim(s) is/are allowed.							
· —	Claim(s) <u>1,23 and 24</u> is/are rejected.							
· ·	Claim(s) 1,9 and 22-24 is/are objected							
•	Claim(s) are subject to restrict		lection requirement.					
Applicati	on Papers							
۵۱۵	The specification is objected to by the	Evaminer						
•	The drawing(s) filed on is/are:		ted or b) Objected to by the	Examiner				
ات/0			•					
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
·	nder 35 U.S.C. § 119							
	-	for foreign pr	iority under 35 H.S.C. & 110/a	1)-(d) or (f)				
· .	12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:							
۵/۱	, ,							
	<ul> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> </ul>							
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage</li> </ul>								
	application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.								
Attachmen	t(s)							
_	e of References Cited (PTO-892)		4) Interview Summary	y (PTO-413)				
2) Notic	e of Draftsperson's Patent Drawing Review (P	TO-948)	Paper No(s)/Mail D	)ate				
_	nation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date	5) Notice of Informal 6) Other:	ratent Application					

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### **DETAILED ACTION**

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Claims 1, 9 and 22-24 are currently pending in the instant application. Claims 1, 23 and 24 are rejected. Claims 1, 9 and 22-24 are objected.

#### Election/Restrictions

Applicant's election of Group I and the further election of the species:

in the reply filed on 18 September 2009 has been acknowledged and the elected species appears allowable over the prior art of record.

Applicants' amendment filed 9 March 2010 has overcome the 35 USC 112 2<sup>nd</sup> paragraph rejection of claims 1, 23 and 24. As applicant has deleted carboxyl from the variable R1 in the claims, the 35 USC 102(b) rejection as being anticipated by the species 7-(2-tetrahydrofuryl)-xanthone-2-carboxylic acid is overcome.

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Therefore, according to MPEP 803.02, the search and examination has been extended to the non-elected species of

methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate

As this non-elected species has been found not allowable, the Markush-type claims have been rejected and claims to the non-elected invention held withdrawn from further consideration.

Claims 1, 9 and 22-24 have been examined to the extent that they are readable

on the elected embodiment, the elected species of

and the species

methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate

. Since the

non-elected species was found not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope of claimed is not patentable.

As a non-elected species has been rejected under 35 USC 102(b), the claim objection is maintained.

# Maintained Claim Objections

Claims 1, 9 and 22-24 are objected to as containing non-elected subject matter.

Claims 1, 9 and 22-24 presented drawn solely to the elected embodiment would overcome this objection or an amendment to overcome the pending rejections in the instant application would overcome this objection as the search and examination of the claims according to MPEP 803.02 would continue.

## New Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,835,158.

US Patent No. 3,835,158 discloses compounds of the formula (A) useful for the treatment of symptoms associated with allergic manifestations, such as asthmatic conditions (column 1, lines 5-20). Column 2, lines 40-50 disclose pharmaceutical compositions, including combinations with other compounds such as antibiotics. An

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example of a compound of the formula (A) is found in example 9:

methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate , column 21 which

corresponds to applicants' claimed invention wherein A is a 5 membered aliphatic ring containing 1 heteroatom of oxygen; n is 0; each Z is CRb wherein Rb is hydrogen; X is O; m is 1; and R1 is carboxy which is defined on page 18 of the instant specification to be COORd and Rd in claim 1 can be alkyl, i.e. methyl. The antibiotic of column 2 corresponds to the antineoplastic agent required in claim 24, see page 27 of the instant specification wherein antibiotics are listed in chemotherapeutic agents.

#### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rebecca Anderson/ Primary Examiner, AU 1626

26 May 2010

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600

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